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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,615	09/17/2001	Wolfgang Neifer	07904.0052	9101
22852	7590	12/09/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			CHAI, LONGBIT	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,615

Applicant(s)

NEIFER, WOLFGANG

Examiner

Longbit Chai

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 17 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-21-2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment

1. Claims 1 – 21 have been presented for examination. Claims 1 – 21 have been amended in a preliminary amendment filed 01/23/2002. Claims 1 – 21 have been examined.

Priority

2. The application is filed on 09/17/2001 but claims the benefit of foreign priority has been made and acknowledged.

Therefore, the effective filing date for the subject matter defined in the pending claims in this application is 03/18/1999 on the benefit of foreign priority date.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make

Art Unit: 2131

and/or use the invention. The claim limitation "said session key is adapted to a secured transfer of said first authorization code" is not enabled by the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said session key" in the 3rd Line of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 6, 8 – 16 and 18 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas (Patent Number: 4757534), hereinafter referred to as Matyas, in view of Civanlar (Patent Number: 6005935), hereinafter referred to as Civanlar.

Art Unit: 2131

As per claim 1 and 18, Matyas teaches a method of securing data on portable mass storage comprising:

a) storing data in scrambled form on said mass storage (Matyas: see for example, Column 4 Line 62 – 65);

c) storing at least one descrambling key on said at least one SAM module for said authorized user, wherein said descrambling key is adapted to descrambling said data (Matyas: see for example, Column 8 Line 11 – 13 and Column 7 Line 53 – 54);

d) assigning a first authorization code to said data (Matyas: see for example, Column 6 Line 10 – 17);

e) storing said first authorization code on said at least one SAM module (Matyas: see for example, Column 7 Line 48 – 50) & (Matyas: see for example, Column 9 Line 54 – 66);

g) storing said second authorization code on said mass storage (Matyas: see for example, Column 6 Line 15 – 17);

Furthermore, Matyas teaches encoding a second authorization code on diskette module using said encryption key (Matyas: see for example, Column 6 Line 10 – 17).

However, Matyas does not disclose expressly the key is a personal identity code.

Civanlar teaches the key is a personal identity code (Civanlar: see for example, Column 2 Line 6 – 7).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Civanlar within the system of Matyas because Civanlar teaches a method to enhance the security by preventing the person holding the key disseminating the information to anyone s/he wants when distributing securing information (Civanlar: see for example, Column 1 Line 35 – 45).

Therefore, Matyas as modified further teaches:

b) storing a personal identity code for an authorized user on at least one SAM module for secured access by said authorized user, wherein said at least one SAM module is comprised in a replay system (Matyas: see for example, Column 6 Line 10 – 17) & (Civanlar: see for example, Column 1 Line 35 – 45);

f) encoding a second authorization code on diskette module using said personal identification code (Matyas: see for example, Column 6 Line 10 – 17) & (Civanlar: see for example, Column 1 Line 35 – 45);

h) decoding said second authorization code on said at least one SAM module using said personal identity code (Matyas: see for example, Column 7 Line 50 – 52, Column 7 Line 48 – 50, Column 9 Line 54 – 66, Column 6 Line 10 – 17) & (Civanlar: see for example, Column 1 Line 35 – 45); and

i) comparing said first authorization code and said second authorization code (Matyas: see for example, Column 7 Line 50 – 52, Column 7 Line 48 – 50, Column 9 Line 54 – 66, Column 6 Line 10 – 17) & (Civanlar: see for example, Column 1 Line 35 – 45);

Art Unit: 2131

j) descrambling said data using said descrambling key if said first authorization code matches said second authorization code ((Matyas: see for example, Column 7 Line 50 – 52, Column 7 Line 48 – 50, Column 9 Line 54 – 66, Column 6 Line 10 – 17) & (Civanlar: see for example, Column 1 Line 35 – 45).

As per claim 2, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified further teaches transmitting a system certificate from said at least one SAM module to a provider for verification prior to purchasing said data (Matyas: see for example, Column 3 Line 26 – 34 and Column 2 Line 42 – 45).

As per claim 3, Matyas as modified teaches the claimed invention as described above (see claim 1 or 2). Matyas as modified further teaches transferring a session key to said at least one SAM module for said authorized user, wherein said session key is adapted to a secured transfer of said first authorization code (Matyas: see for example, Column 7 Line 41 – 42).

As per claim 4, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified further teaches linking said data to an identification, wherein said identification comprises personal features of said authorized user (Civanlar: see for example, Column 2 Line 6 – 7).

As per claim 5, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified further teaches collecting at least part of said personal identity code from said authorized user using a fingerprint sensor (Civanlar: see for example, Column 2 Line 62 – 64: fingerprint can be considered as one of obvious types of information that is personal to the buyer that is not easily known to others).

As per claim 6, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified further teaches said mass storage is adapted to plugging into a plug-in type module, wherein said module is adapted to plugging into said replay system (Matyas: see for example, Column 4 Line 62 – 65: Diskette is a plug-in type module).

As per claim 8, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified further teaches a first SAM module is adapted to communication between said replay system and a provider of said data, and a second SAM module is adapted to collection of said personal identity code for storage on said mass storage (Matyas: see for example, Column 4 Line 62 – 65: Diskette is a plug-in type module) & (Civanlar: see for example, Figure 2 Element 38, 26 and 20).

Art Unit: 2131

As per claim 9, Matyas as modified teaches the claimed invention as described above (see claim 8). Matyas as modified further teaches said mass storage is adapted to plugging into a plug-in type module, wherein said module is adapted to plugging into said replay system, wherein said second SAM module is integrated into a plug-in type module (Matyas: see for example, Column 4 Line 62 – 65: Diskette is a plug-in type module) & (Civanlar: see for example, Figure 2 Element 38).

As per claim 10, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified does not disclose said mass storage comprises a miniaturized hard disk. Official Notice is taken that the use of miniaturized hard disk as the mass storage device is one of the well-known methods in the field. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use miniaturized hard disk as the mass storage.

As per claim 11, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified does not disclose said mass storage comprises a flash semiconductor storage. Official Notice is taken that the use of a flash semiconductor storage as the mass storage device is one of the well-known methods in the field. Therefore, it would have been obvious to a

Art Unit: 2131

person of ordinary skill in the art at the time the invention was made to use a flash semiconductor storage as the mass storage device.

As per claim 12, Matyas as modified teaches the claimed invention as described above (see claim 11). Matyas as modified further teaches said flash semiconductor storage is adapted to plugging into an interface module, wherein said interface module is adapted to plugging into said replay system (Matyas: see for example, Figure 1 Element 101).

As per claim 13, Matyas as modified teaches the claimed invention as described above (see claim 12). Matyas as modified further teaches said interface module comprises a SAM card reader, wherein said SAM card reader is adapted to receiving said at least one SAM module (Matyas: see for example, Figure 1 Element 101).

As per claim 14, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified further teaches a remote access to a network is adapted to communication between said replay system and a provider for purchasing said data (Civanlar: see for example, Figure 2 Element 38, 26 and 20).

As per claim 15, Matyas as modified teaches the claimed invention as described above (see claim 14). Matyas as modified further teaches said replay system comprises a card reader module, wherein said card reader module is adapted to plugging into said replay system, wherein said card reader module comprises a chip card reader and a SAM card reader, wherein said SAM card reader is adapted to receiving said at least one SAM module (Matyas: see for example, Figure 1 Element 16 and 101).

As per claim 16, Matyas as modified teaches the claimed invention as described above (see claim 1). Matyas as modified further teaches at least partially encrypting said descrambling key using said personal identity code; and at least partially decrypting said descrambling key using said personal identity code (Matyas: see for example, Column 8 Line 11 – 13) & (Civanlar: see for example, Column 2 Line 6 – 7).

As per claim 19, Matyas as modified teaches the claimed invention as described above (see claim 18). Matyas as modified further teaches a payment system comprising a chip card reader, said payment system adapted to conditional access to a provider of said data using a remote network (Matyas: see for example, Figure 1 Element 5).

As per claim 20, Matyas as modified teaches the claimed invention as described above (see claim 19). Matyas as modified further teaches said chip card reader is adapted to a plug-in type PC card in the PCMCIA format (Matyas: see for example, Figure 1 Element 5).

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas (Patent Number: 4757534), hereinafter referred to as Matyas, in view of Civanlar (Patent Number: 6005935), hereinafter referred to as Civanlar, and in view of Ruell (Patent Number: 4394773), hereinafter referred to as Ruell.

As per claim 7, Matyas as modified teaches the claimed invention as described above (see claim 6). Matyas as modified does not disclose expressly collecting at least part of said personal identity code from said authorized user using a fingerprint sensor, wherein said fingerprint sensor is adapted to a surface of said plug-in type module.

Ruell teaches collecting at least part of said personal identity code from said authorized user using a fingerprint sensor, wherein said fingerprint sensor is adapted to a surface of said plug-in type module (Ruell: see for example, Column 4 Line 40 – 42).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ruell within the system of Matyas as modified because (a) Matyas as modified teaches the security key is

Art Unit: 2131

associated with personal information, and (b) Ruell teaches providing a fingerprint sensor with low cost, high sensitivity and high reliability that can adapt to a plug-in module of a computer terminal (Ruell: see for example, Column 3 Line 8 – 10).

7. Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas (Patent Number: 4757534), hereinafter referred to as Matyas, in view of Civanlar (Patent Number: 6005935), hereinafter referred to as Civanlar, and in view of Camp (Patent Number: 6076078), hereinafter referred to as Camp.

As per claim 17 and 21, Matyas as modified teaches the claimed invention as described above (see claim 1 and 19/20 respectively). Matyas as modified does not disclose expressly stamping said data with a certified time stamp, wherein said certified time stamp is stored on said mass storage.

Camp teaches stamping said data with a certified time stamp, wherein said certified time stamp is stored on said mass storage (Camp: see for example, Column 13 Line 65 – 66).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Camp within the system of Matyas as modified because (a) Matyas as modified teaches purchasing a diskette containing an encrypted program with the associated payment per computer basis (Matyas: see for example, Column 8 – 29), and (b) Camp teaches providing a

Art Unit: 2131

certified life time for the associated files so that the stalling action from a user after expiration time can be prevented (Camp: see for example, Column 14 Line 8 – 13).

Art Unit: 2131

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Longbit Chai
Examiner
Art Unit 2131

LBC

E. L. Moise
EMMANUEL L. MOISE
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